

REMARKS

This is a response to the office action issued June 27, 2006. In that action, the examiner objected to claims 58-59 and 62-67 as being in improper dependent form. Claims 58-59 have been amended. Claims 63-65 and 67 have been cancelled. Claim 62 depends on claim 59.

The examiner rejected claims 46-52, 54-59 and 62-67 under 35 U.S.C. §112, first paragraph for containing matter not disclosed. The examiner states that the applicants cannot support the term "non-saturated fatty tail" with the specification. Fig. 1 clearly shows non-saturated fatty tails. The compounds in Fig. 1 are fatty acids and esters made from fatty acids. Each fatty acid tail contains at least one non-saturated link. The examiner also states that the applicant does not disclose an "allyl" structure CH₂=CH-CH₂- in the disclosure. Again the examiner is directed to Fig. 1.

The examiner also rejected claims 46-47, 57-59 and 62-67 under 35 U.S.C. §112, 2nd paragraph for being indefinite. The applicant has removed the transitional phrase "consisting essential of" and replaced it with

"comprising". As to "allyl", kindly see the previous paragraph. The applicant disagrees that allyl does not contain an oleic tail. Oleic acid is $\text{CH}_3(\text{CH}_2)_7\text{CH}=\text{CH}(\text{CH}_2)_7\text{COOH}$. According to the Wikipedia Dictionary: "Substituted versions of the above [CH₂=CH-CH₂-], such as the *trans*-but-2-en-1-yl or *crotyl* group (CH₃CH=CH-CH₂-) may be also referred to as allylic groups." (bracketed material entered by the applicant). The applicant believes Oleic acid falls under this. The applicant also believes that allyl does not necessarily require double bond to appear at any particular location.

The examiner rejected claim 48 under 35 U.S.C. §102(b). Claim 48 has been cancelled.

The examiner issued a provisional double patenting rejection over co-pending application 11/209,377. The applicant will cure this with a terminal disclaimer when there are allowed claims.

The examiner rejected claims 46-47, 49-52, 54-59 and 62-67 under 35 U.S.C. §103(a) as being unpatentable over ICI Industries Limited (GB 2 007 215).

The ICI reference lists certain acids or halogen-acid derivatives including: monochloroacetic acid, dichloroacetic acid, trichloroacetic acid, monobromoacetic

acid, glycollic acid, propionic acid, n-butyric acid, n-hexanoic acid, n-octanoic acid, decanoic acid, dodecanoic acid, hexadecanoic acid, stearic acid, cyclohexane carboxylic acid, phenylacetic acid, benzoic acid, o-, m- and p-toluic acid and naphthoic acid. None of these acids have an unsaturated fatty tail such as oleic acid. The issue is whether a person of ordinary skill in the art at the time of the invention would choose a non-saturated fatty acid which are usually insoluble in water to produce a bromonitro ester for an aqueous metal working system. ICI teaches away from fatty tails by not mentioning a single non-saturated acid. A person of ordinary skill would know that non-saturated compounds have very different physical and chemical properties than the saturated or ring compounds ICI names. A simple example is bond angles which are quite different on non-saturated bonds. Another example is water solubility.

A reference must be considered for all that it teaches, disclosures that diverge and teach away from the invention at hand as well as disclosures that point toward and teach the invention. See. In re Dow Chem. Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Whether or not changes from the prior art are minor, they must be

evaluated in terms of the whole invention including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's invention. Jones v. Hardy, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

ICI teaches only unsaturated tails. It therefore teaches away from the applicant's invention. ICI contains no suggestion or teaching to one of ordinary skill in the art to use non-saturated fatty tails.

For these reasons, the applicant believes that the claims are allowable. The examiner is respectfully requested to place the case in condition for allowance at his earliest convenience.

Respectfully submitted



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